

REMARKS

Claims 13, 15-23, 35, 38-40, 46-49 and 59-67 were examined. Claims 13, 15, 22, 59-61, 63, 65, and 67 have been newly amended. Claims 1-12, 14, 24-34, 36-37, 41-45, 50-58 and 68-72 were previously canceled. Claims 35, 38-40, 46-49, 62, and 66 are newly canceled. Support for these amendments is identified in the following remarks. No new matter has been added by these amendments.

Claim Rejections under 35 U.S.C. §103(a)

Claims 13, 15-19, and 21 are rejected as allegedly being unpatentable over Higgins III in view of DiLeo. Claim 20 is rejected as allegedly being unpatentable over Higgins III in view DiLeo and further in view of Gabower. Claims 22 is rejected as allegedly being unpatentable over Higgins III in view of DiLeo and further in view of Denzene et al. Claim 23 is rejected as allegedly being unpatentable over Higgins III in view of DiLeo. Such rejections are traversed for the following three reasons.

First, there must be some suggestion of a desirability of the combination. *See* MPEP § 2143.01. The mere mentioning of vacuum metallizing a metal layer over plastics in DiLeo is insufficient to establish the motivation to modify Higgins III. The fact that Higgins III and DiLeo can be combined is not sufficient to establish *prima facie* obviousness. In determining whether there is a motivation to combine references, the Examiner must consider the references in their entirety. *See* MPEP §2141.02.

However, in rejecting the claims, the Examiner focused on one sentence in the background (col. 1, lines 27-29) and disregarded the remainder of the DiLeo disclosure. The entire DiLeo description, except for the single referenced sentence in the background section, is directed toward polymer based aqueous coating composition for molded plastics. A person reading the DiLeo reference as a whole would not be motivated to combine the vacuum

metallization method described in the single sentence in the background with Higgins III to come to the Applicants claimed invention.

Applicants disagree with the Examiner's statement that "DiLeo reference cites several advantages (i.e., cost effective, environmentally desirable, and consistent as stated in column 1, lines 27)..." In fact, a closer reading of DiLeo reveals that DiLeo actually states that "plastic plating is expensive, environmentally undesirable, and inconsistent." While the next sentence discusses vacuum metallization, there is nothing in DiLeo which states that vacuum metallizing actually solves the deficiencies of plastic plating. There is nothing in DiLeo which provides a suggestion of using vacuum metallization with Higgins III.

Second, the references would appear to teach against modifying the polymer based conductive layer of Higgins III with a vacuum metallized layer. In particular, a person of ordinary skill in the art reading both Higgins III and DiLeo would see that both Higgins III and DiLeo teach polymer based conductive layers. DiLeo describes their polymer based, aqueous coating composition at col. 2, lines 1-21. Higgins III describes a compounded, polymer based, general purpose structure at col. 4, lines 31-55. Higgins III structure has one or more electrically conductive layers that include particulate-filled polymers.

Importantly, Higgins III recites that the electrically conductive layer "should also contain dielectric materials which are highly lossy at E-field frequencies present in the EMI field." (col. 4, lines 41+) If the polymer/dielectric based EMI layer of Higgins III is replaced with the vacuum metallized layer, as suggested by the Examiner, the resultant shield would no longer have the dielectric material, as desired by Higgins III. Consequently, the modification proposed by the Examiner would appear to change the principle of operation of Higgins III (e.g., no dielectric layer), which is evidence against *prima facie* obviousness. See MPEP §2143.01.

Finally, because both Higgins III and DiLeo both describe polymer based EMI shield layers, even if *arguendo* a person of ordinary skill in the art were to combine the references, at best the resultant combination would include the insulating conformal layer of Higgins III with the conductive, polymer based aqueous coating composition of DiLeo.

For the above reasons, independent claim 13 is allowable over the cited references. Dependent claims 15-23 should be allowable at least for depending from allowable independent claim 13. Additionally, the dependent claims further provide novel aspects that are not described or suggested by the cited references. For example, dependent claim 18 recites applying an insulating conformal coating over the first conductive layer. Claim 19 recites that the insulating conformal coating is waterproof. The Examiner cited to col. 6, line 21 of Higgins III to reject these claims. However, in reviewing Higgins III, the conformal insulative layer or coating 24 described in Higgins III refers to the base coating. The base coating is not disposed over the conductive layer (as is required by dependent claims 18 and 19), but instead is disposed under the conductive layer(s). As is described in Applicants originally filed specification at page 9, lines 14+, the insulating conformal coating may be used to insulate the conductive layer from surrounding electronics. The insulating conformal coating may also be waterproof (claim 19) to prevent infiltration of liquids.

Claims 35 and 38-40 are rejected as allegedly being unpatentable over Higgins in view of DiLeo and further in view of Denzene et al. Claims 46-49 are rejected as allegedly being unpatentable over Gabower in view of Denzene et al. To expedite prosecution of the present application, Applicants are canceling claims 35, 38-40 and 46-49. Applicants herein reserve the right to pursue claims of the original scope or claims of similar scope in a continuation application, divisional application, or a continuation-in-part application.

Claims 59-66 are rejected as allegedly being unpatentable over Lacey in view of Askew. Claim 67 is rejected as allegedly being unpatentable over Lacey in view of Askew and further in view of Gabower. Such rejections are traversed in part and overcome in part as follows.

In the office action, the Examiner interpreted the PCB 5B of Lacey to correspond to the claimed "base portion of the metallized substrate shield body" and the metallized top layer 14 to correspond to the "top portion of the metallized shield body." While Applicants disagree with the Examiner's interpretation of Lacey, to expedite prosecution of the present application

and to more clearly differentiate the base portion and top portion of the shield body from the printed circuit board, Applicants have amended independent claim 59 to specify that the ground trace is disposed on the printed circuit board. Thus, claim 59 recites attaching a base portion of a metallized substrate shield body to a ground trace disposed on the printed circuit board and removably coupling a top portion of a metallized substrate shield body to the base portion of the metallized substrate shield body to enclose the electronic component.

In contrast, Lacey merely illustrates a ground trace disposed on the printed circuit board and a unibody shield coupled to the ground trace. There is simply no description or suggestion of a top portion of a metallized substrate shield body removably coupled to a base portion of a metallized substrate shield body that is attached to a ground trace. Applicants believe that amended claim 59 is now clearly allowable over Lacey and Askew.

Dependent claims 60-61, 63-65 and 67, which depend from allowable independent claim 58 should be allowable at least for depending from allowable independent claim 59. Additionally, the dependent claims further provide novel aspects not described or suggested by the Lacey or Askew. For example, claim 60 recites that the base portion comprises a plurality of walls that extend substantially orthogonal to a surface of the printed circuit board and removably coupling comprises overlapping a portion of the top portion over the plurality of walls of the bottom portion. Claim 61 recites positioning protrusions between a periphery of the top portion of the metallized substrate shield body and the base portion of the metallized substrate shield body. Claim 64 recites that the protrusions are spaced no larger than one half a wavelength of electromagnetic radiation emitted from the electronic component. Claim 65 recites that removably coupling comprises inserting a tab in a groove. Lacey and Askew wholly fail to describe or suggest such claims.

Applicants note that MPEP §2142 requires the examiner to bear the initial burden of factually supporting any *prima facie* conclusion of obviousness, which includes *inter alia* showing all of the claim limitations (emphasis added). The fact that the claimed invention may be within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish

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*prima facie obviousness*. (MPEP §2143.01). Because the Examiner has failed to show all of the claim limitations in the claims dependent claims 60-61, 63-65 and 67 are also allowable.

If the Examiner is to maintain the rejection of claims 59-61, 63-65 and 67, Applicants respectfully request that the Examiner explicitly indicate where the references disclose each of the claim limitations.

CONCLUSION

In view of the foregoing, Applicants respectfully request reconsideration of the pending claims in this application. If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

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